

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application.

Claims 1-28 are now present in this application. Claims 1, 11, 21 and 26-28 are independent.

Amendments have been made to the Title, Abstract of the Disclosure and specification, claims 26-28 have been added, and claims 1, 4-9, 11-17 and 19-21 have been amended. No new matter is involved.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. §119

Applicants thank the Examiner for correctly acknowledging Applicants' claim for foreign priority under 35 U.S.C. §119, and receipt of the certified priority document on the Form PTO-326.

However, on page 2, the Office Action, under the heading "Priority," incorrectly states that "the certified copy [of Applicant's priority application] has been filed in parent Application No. 200/38493, filed on 7/6/2000."

Applicant respectfully requests that this misstatement be withdrawn in the next Office Action.

Title of the Invention

Applicant has amended the Title of the Invention in order to better reflect the subject matter claimed.

Abstract of the Disclosure

Applicant has amended the Abstract of the Disclosure in order to place it in better form.

Specification Objection

The Examiner has objected to the specification because of several informalities. In order to overcome this objection, Applicants have amended the specification in order to correct the deficiencies pointed out by the Examiner. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Objections

The Examiner has objected to claims 4, 5 and 8 because of several informalities. In order to overcome this objection, Applicants have amended claims 4 and 8 to correct the deficiencies pointed out by the Examiner. Reconsideration and withdrawal of this objection are respectfully requested.

Claim Amendments

Applicants have amended the claims in order to place the claims in better form. These claim amendments are not being made in response to any statutory requirement for patentability, and have not been narrowed in scope. Instead, the claims have been amended merely to recite the subject matter therein more clearly.

Rejections under 35 U.S.C. §103

Claims 1-5, 9, 11-13 and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,172,220 to Beis in view of U.S. Patent 6,046,863 to Chino. This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability. In *re* Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In *re* Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden, then the applicant is entitled to the patent.

A rejection must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Beis is directed to an optical monitoring system having a video camera with a first sensing unit to produce black and white images and a second sensing unit for producing color images. See the abstract of Beis, in this regard. When the incoming light is in a range below a certain threshold, Beis activates the black and white sensing means and deactivates the color sensing means and, when the incoming light is in a range above the threshold, Beis activates the color sensing means and deactivates the black and white sensing means. See the claims of Beis in this regard. Beis discloses a single lens element or objective 1.

The Office Action clearly admits that Beis does not disclose the details of its lens system.

Applicant respectfully submits that not only does Beis not disclose the details of its lens system, but Beis also does not disclose any control movement of its lens in general, let alone in accordance with the photographing mode set on the basis of comparing the detected illumination with a reference illumination, as recited, or by loading corresponding pre-stored trace data of the lens, also as recited.

To remedy these deficiencies, the Office Action turns to Chino.

Chino discloses a digital video cassette recorder (VCR) that has a zoom lens and an auto-focus mechanism that maintains the image in focus while the lens is zoomed. See Col. 1, lines 13-20, for example. Chino's invention is

directed to a VCR that inserts a neutral density (ND) filter into and removes the neutral density filter from the optical path of its zoom lens – see col. 4, lines 28-33. Chino discloses that when the ND filter is inserted into, or removed from, the optical path of its zoom lens, the lens goes out of focus – see col. 4, lines 53-61, for example.

Chino's invention is directed to eliminating the out-of-focus problem that is caused by insertion and/or removal of a neutral density filter from his VCR zoom lens path – see, for example, cols. 5-8 and Chino's claims.

In rejecting claims under 35 U.S.C. §103, it is incumbent on the Examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657,

664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. These showings must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999). Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Moreover, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

Also, the factual inquiries set forth in Graham v. John Deere, 383 U.S. 1, 148 USPQ 459 (1966) that should be applied to establish a background for determining obviousness should be made.

However, these inquiries are not found in the Office Action with respect to independent Claim 1.

The Office Action concludes that it would be obvious to modify Beis with the zoom lens of Chino to use the zoom lens of Chino to provide detailed images of far away objects. The rationale for this is the allegedly well known ability of a zoom lens to allow distant objects to be imaged and the unsupported conclusion that providing a zoom lens for Beis would enhance its surveillance function.

Going even further, the Office Action speculatively asserts that the zoom capability provided by Chino would operate with the set photographing mode because zooming would take place in both modes.

Applicant respectfully submits that the Office Action fails to meet its burden of demonstrating proper motivation for one of ordinary skill in the art to modify Beis as proposed.

First, the Office Action does not address the fact that Beis and Chino are concerned with distinctly different problems, and that they function differently. Beis discloses a surveillance camera with a fixed lens that is not adjusted and cannot zoom, and contains no disclosure or suggestion of using a zoom lens

system or a zoom lens system with autofocus or a system that uses a neutral density filter that upsets autofocus.

Second, Chino contains no disclosure of (1) a surveillance camera, (2) how to identify an object of interest to zoom in on or away from in a surveillance operation; (3) how to track an object of interest to zoom in on or zoom away from in a surveillance operation.

Third, the Office Action fails to provide objective evidence that one or ordinary skill in the art would desire to modify a fixed focus surveillance camera like that of Beis with a sophisticated autofocus zoom lens system incorporating a neutral density filter.

As pointed out above, the mere fact that these two references may be combined in some way does not make the modification obvious unless the prior art suggested the desirability of the modification.

All that is presented in terms of motivation is the alleged desirability of providing detailed images of far away objects. However, this statement is nothing more than a broad, conclusory speculative statement that, standing alone, is not evidence of motivation to modify Beis and provide a Beis with a zoom lens having autofocus characteristics and a neutral density filter. See In re Dembiczak, cited above, in this regard.

Moreover, even if these references were combined as suggested, they would not result in the claimed invention because Beis does not control

movement of its lens at all and there would be no incentive to move the newly applied Beis-Chino zoom lens in accordance with the set (b/w or color detection) photographing mode. The only incentive to control movement of the Beis-Chino zoom lens would be when the lens goes out of focus, but this is not what is claimed.

Furthermore, with respect to claim 11, there is no disclosure in either applied reference of correlating first trace data to a daylight mode and second trace data to nighttime mode. Presumably, Chino's zoom lens goes in and out of focus only when a neutral density filter is inserted into or removed from the lens path, and there is no disclosure of relating the insertion and/or removal of the neutral density filter to operation in a daytime or nighttime mode, and Bais doesn't even address the issue of using a neutral density filter. In short, there is absolutely no disclosure in either reference of the relationship of the first trace data to a daylight mode and second trace data to nighttime mode or of controlling movement of a lens on the basis of the recited first and second trace data.

Furthermore, a factual inquiry whether to modify a reference must be based on objective evidence of record, not merely conclusory statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As neither applied reference even suggests controlling movement of a lens in accordance with a photographing mode set on the basis of comparing

detected illumination with a reference illumination value by loading pre-stored lens trace data, and with respect to claim 11, first trace data with respect to a daylight mode and second trace data with respect to a nighttime mode, the motivation for modifying Beis to include such a feature must be based on speculation and/or impermissible hindsight.

Accordingly, this Office Action fails to make out a *prima facie* case of proper motivation to combine these references in the manner suggested, and therefore fails to make out a *prima facie* case of obviousness of the claimed invention.

Reconsideration and withdrawal of this rejection of claims 1-5, 9, 11-13 and 17 is respectfully requested.

Claims 6-8, 10, 14-16 and 18-25 stand rejected under 35 USC §103(a) as unpatentable over Beis in view of Chino, and further in view of U.S. Patent 5,959,669 to Mizoguchi. This rejection is respectfully traversed.

First, the Beis-Chino reference combination is improper for the reasons stated above and those reasons are incorporated herein by reference.

Second, Beis does not disclose a need for an OLPF. As pointed out in the rejection, with reference 4 to Beis, 6, lines 33-39, Beis uses a simple infrared cutoff filter. An infrared filter cuts off (absorbs) infrared radiation and passes visible light. Beis' infrared filter cuts off (absorbs) just the high (infrared) frequencies, while passing the visible frequencies. Without a showing of a

need for an OLPF, there is no need to even consider the Mizoguchi reference. Beis discloses no need for such a filter and the Officer Action fails to present objective evidence of such a need.

Applicants respectfully point out that merely because the prior art can be modified in the manner suggested by the Examiner does not render the modification obvious unless the prior art suggests the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir, 1992).

Moreover, Mizoguchi is concerned with different issues than are Beis and Chino. Beis is concerned with photographing documents (col. 1, lines 35-55) and uses different crystal low pass filters depending on the resolution employed – see col. 3, lines 5-40, for example. Whereas Beis is concerned with surveillance using a fixed focus lens 1, and Chino is interested in maintaining autofocus in a zoom lens system when the system becomes out of focus due to insertion or removal of a neutral density filter in the path of the zoom lens. Mizoguchi is directed to imaging different objects with different characteristics than either Beis or Chino. For example, Beis does not disclose that it is carrying out surveillance on documents with different resolutions.

There is no objective evidence of record that would provide proper motivation for one of ordinary skill in the art to turn to the high resolution document camera art that employs a crystal low pass filter designed to reduce

or eliminate an aliasing distortion or color moiré in Beis' system, which has no indication that it has such problems. Moreover, Chino does not disclose that it has the problems that are addressed by Mizoguchi.

This is persuasive evidence that the rejection is based on improper hindsight reconstruction of Applicant's invention based solely on Applicant's disclosure and on the improper practice of picking and choosing individual references to combine without any proper motivation to do so absent solely following Applicant's disclosure to achieve the claimed invention.

The Office Action is picking and choosing references that are not concerned with the same issues and combining them in a completely arbitrary manner based solely on Applicant's disclosure in a completely improper hindsight manner.

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to combine these references in the manner suggested, and therefore fails to make out a *prima facie* case of obviousness of the claimed invention.

Further, with respect to claim 21, there is no disclosure in either applied reference of relating first trace data to a daylight mode and second trace data to nighttime mode. Presumably, Chino's zoom lens goes in and out of focus only when a neutral density filter is inserted into or removed from the lens path, and there is no disclosure of relating the insertion and/or removal of the

neutral density filter to operation in a daytime or nighttime mode, and Beis doesn't even address the issue of using a neutral density filter. In short, there is absolutely no disclosure in either reference of the relationship of the first trace data to a daylight mode and second trace data to nighttime mode or of controlling movement of a lens on the basis of the recited first and second trace data.

Reconsideration and withdrawal of this rejection of claims 6-8, 10, 14-16 and 18-25 is respectfully requested.

New Claims

Claims 26-28, which are device/apparatus claims that correspond to claims 1, 11 and 21, have been added. Claims 26-28 are deemed patentable over the applied art for the reasons that claims 1, 11 and 21, which recite similar method steps, are patentable over the applied art, for reasons stated above.

Accordingly, consideration and allowance of claims 26-28 is respectfully requested.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

The Examiner is also respectfully requested to withdraw the priority statement on page 2 of the outstanding Office Action for the reasons stated above.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 39,538, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

Application No.: 09/899,066
Art Unit 2615

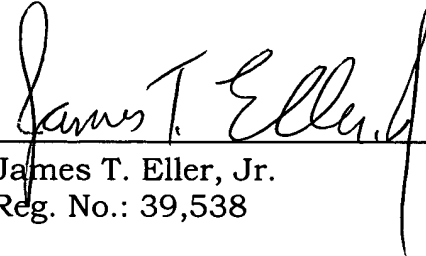
Attorney Docket No. 0630-1287P
Reply to April 22, 2004 Office Action
Page 29


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:


James T. Eller, Jr.
Reg. No.: 39,538

JTE/RJW/adt 

P.O. Box 747
Falls Church, Virginia 22040-0747
Telephone: (703) 205-8000

Attachment: Abstract of the Disclosure